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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,938	01/15/2004	William Patrick Gray	032279.00063	6531

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/758,938	Applicant(s) GRAY, WILLIAM PATRICK	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a putter/hosel, classified in class 473, subclass 313.
 - II. Claims 10-12, drawn to a method of assembling a putter, classified in class 473, subclass 409.
 - III. Claims 13-15, drawn to a kit for assembly of putters, classified in class 473, subclass 288.
2. The inventions are distinct, each from the other because of the following reasons:
 - a. Inventions of the putter/hosel and the method of assembling a putter are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a putter can be made by not selecting from a group of heads, shafts and hosel but individually made.

b. Inventions of a putter/hosel and a kit for assembly are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case a kit is not needed to make a putter. One skilled in the art can make an individual putter without needing a kit.

c. Inventions of a method of assembling a putter and a kit for assembly are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of assembling a putter as claimed in claim 10 can be practiced with another materially different product as heads having different bore sizes and bushings are used to fit different sized hosel projections with different head bore sizes.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Mr. Henry S. Jaudon (Reg. No. 34,056) on about 21 January 2005 a provisional election was made without traverse to prosecute the invention of the putter/hosel, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Farmer.

Farmer discloses a putter (Fig. 1) having a sole (Fig. 10C), a top, a back (Fig. 1), a face (Fig. 10C), a bore in a top (Figs. 1A, 3, Ref. No. 38, Col. 7, Lns. 21-22), a hosel having an upper portion and a foot (Fig. 1), a foot having a projection to fit in a bore (Fig. 3, Col. 7, Lns. 21-22), a hosel having an elbow adjacent an upper portion (Fig. 2A), a receptacle being formed in a elbow (Col. 6, Lns. 52-58), a shaft having a length and

having a flex (Fig. 1), a shaft having a first end to fit into a receptacle (Col. 6, Lns. 52-58) and a second end to support a grip (Fig. 2A), and a cavity back head (Fig. 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer in view of Lee.

Farmer discloses a receptacle arranged at a selected angle relative to an axis of a body (Fig. 14).

Farmer lacks a hosel formed of a square, a foot of a hosel including a shoulder located above a projection, a shoulder having vertical sides, a head having a recess having vertical walls formed about a bore, and a shoulder secured in a recess with sides engaged with the walls forming a non-rotating engagement. Lee disclose a hosel formed of a polygon in the form of a square and a foot of a hosel including a shoulder located above a projection, a shoulder having vertical sides, a head having a recess having vertical walls formed about a bore, a shoulder secured in a recess with sides engaged with the walls forming a non-rotating engagement (Figs. 3-4). In view of the

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patent of Lee it would have been obvious to modify the putter of Farmer to have a hosel formed of a square, a foot of a hosel including a shoulder located above a projection, a shoulder having vertical sides, a head having a recess having vertical walls formed about a bore, and a shoulder secured in a recess with sides engaged with the walls forming a non-rotating engagement in order to ensure a hosel stays aligned and does not rotate once inserted into a head having a bore.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer in view of Wu.

Farmer lacks a head being made from a material and a hosel from another material. Wu discloses a neck being made of a different material than a head (Col. 2, Lns. 62 through Col. 3, Lns. 20) in order to move the center of gravity of a head to match a striking posture of a specific golfer (Abstract). In view of the patent of Wu it would have been obvious to modify the putter of Farmer to have a head being made from a material and a hosel from another material in order to move the center of gravity of a head to match a striking posture of a specific golfer.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer in view of Lee as applied to claims 2, 5-7, and 9 above, and further in view of Delio and Examiner's Official Notice.

Farmer discloses a variety of different hosels (Col. 8, Lns. 28-37) and a hosel having a length (Fig. 1).

Farmer lacks a hosel having a length between 1-3 inches. Delio discloses a hosel having a length of about the size of a diameter of a golf ball (Fig. 2). The Examiner takes Official Notice that it is well known that a diameter of a golf ball is about 1.7 inches in length. In view of the patent of Delio and the Examiner's Official Notice it would have been obvious to modify the hosel of Farmer to have a length between 1-3 inches in order to utilize a hosel length used in the art for hosels which have elbows and offsets and in order that the hosel with a offset and elbow does not interfere with the ball when impacting a ball.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 22 January 2005


STEPHEN BLAU
PRIMARY EXAMINER